

REMARKS/ARGUMENTS

Claims 1 to 4, 6, 7, 9 to 12, 14 to 18, and 22 to 39 are now pending in this application. Claims 5, 8, 13, and 19 to 21 have been cancelled. Claims 26 to 39 have been withdrawn from consideration. Claims 1, 14 to 18, and 22 to 25 have been amended to clarify the present invention and to correct dependency and minor informalities.

The Action sets forth that newly submitted claims 29 to 39 are directed to an invention that is independent or distinct from the invention originally claimed. Thus, claims 29 to 39 have been withdrawn from consideration.

Claims 1 to 12, 19, and 21 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Action sets forth that information describing the JISA hardness index is not set forth in the specification in a manner enabling

the skilled artisan to practice the invention as claimed. Furthermore, the Action notes that information essential to practicing the claimed invention can be incorporated only by reference to issued United States patents. The Action argues that essential material incorporated by reference to non-United States patents fails to meet these criteria established under § 112, first paragraph, as failing to adequately teach how to make and/or use the invention, and thereby fail to provide an enabling disclosure.

The Action sets forth that the hardness measures employed in the instant invention are employed routinely, yet this knowledge fails to meet the standard required for issuance of United States Patents. The Action argues that a hardness standard critical to the instant invention must be enabled by disclosed methods, or by reference to an issued U.S. Patent. The Action further states that absent such disclosures, the system employed simply fails to meet the required criteria. Finally, the Action states that the Examiner's burden has been met in that the JISA standard method to determine the hardness standard is not disclosed herein, or set forth by reference to an issued U.S. Patent.

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Applicants once again submit that the Japanese Industrial Standard (JIS) is a well-known testing methods standard. Applicants have previously referred the Examiner to the Internet web site for the Japanese Industrial Standards Association (http://www.jsa.or.jp/default_english.asp). This web site links to an index of the standards, including "Hardness testing methods for rubber, vulcanized or thermoplastic", JIS K 6253, which is identified in the specification. An English language copy of JIS K 6253 has previously been submitted to the Examiner. The test method is a standard, internationally recognized test method readily available in English and other languages, and is no different than identification of an ASTM or other well known test method.

Applicants also submit that this material is not impermissible "essential material incorporated by reference to non-United States Patents", as stated in the Office Action. The JISA hardness index is not incorporated by reference. Rather, it is presented in the application as a well-known standard, and known to one skilled in the relevant art. In fact, many polymer testing scales and devices used in the U.S. comply with JIS, as well as other

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well-known standards. For example, many hardness testers/durometers shore hardness scales commonly used in the art are known to comply with the at least the following standards: JIS, ISO, DIN, and ASTM. A product description of such a scale from Ray-Ran Polytest Advanced Polymer Testing Equipment is being submitted as an attachment to this response (marked as "Attachment A").

Additionally, Applicants submit that many U.S. patents presenting the JIS or JISA standard have been granted by the USPTO. A basic search on the USPTO website by Applicants has revealed at least 616 issued U.S. patents that disclose the JIS standard in relation to hardness. A list of 50 such representative patents is being submitted as an attachment to this response (marked as "Attachment B"). More specifically, Applicants submit that U.S. Patent Nos. 6,710,377 to Shimomura, 6,550,389 to Goto et al., and 6,747,293 to Nitta et al., are three examples of issued U.S. patents that require a JISA hardness value as a necessary element in claim 1 of each respective patent.

The Action has rejected claims 1 to 25 under 35 U.S.C. § 103 as being unpatentable over Dobkowski et al. (U.S.

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Patent No. 6,074,672) and Anderson (European Patent Application No. 01106007.6/Publication No. EP 1 136 064 A2), in view of Yoshimasa et al. (JP 11-216836/Publication No. 2000-103717).

The Action sets forth that Dobkowski et al. and Anderson teach the claimed silicone elastomer, colorant, and nylon fillers as old and well known in combination with various pharmaceutical carriers and excipients in a dosage form. The Action further states that these ingredients are taught as useful for formulating cosmetic formulations and various skin coverings. The Action does concede that claims 1 to 25, and the primary references differ as to the concomitant employment of these medicaments, and the specific hardness of the formulations. With regard to the first concession, the Action sets forth that the instant claims define nothing more than the concomitant use of conventional cosmetic agents, and that therefore, the recited claims define prima facie obvious subject matter. Furthermore, with regard to the specific hardness defined in the claims, the Action sets forth that Yoshimasa et al. employs the recited compounds for the claimed cosmetic use, at a hardness encompassed by the instant claims. The

Action does state that absent specific compression steps, not recited in the instant composition claims, the skilled artisan would expect on normal compression, the cited reference compounds to provide the hardness recited, absent information to the contrary.

The claims of the present application have been amended to more clearly recite the novel aspects of the present invention. As set forth above, the Action sets forth that absent specific compression steps not recited in the composition claims, the skilled artisan would expect the prior art compounds to provide the recited hardness. In response herein, the independent claims now more clearly distinguish over the combination of the Dobkowski et al., Anderson and Yoshimasa et al. references. Specifically, independent claim 1 now includes clarification that the compositions have about 1 wt% to about 25 wt% of silicone elastomer particulates based on the total weight of the composition, and that the compositions have a hardness value of less than about 1500 grams and a percent recovery of at least 25%. Consequently, the aforementioned cited references, whether taken alone or in any combination,

neither disclose nor suggest all of the elements of the claims of the present application.

The products of this invention are pressed powder cosmetics, defined at page 4 of the instant application as "a composition of dry, free-flowing powder that has been compressed to a reduced volume and to a form such that, for example, when pressed into a rigid package, it will substantially maintain its shape and consistency regardless of the positioning of the package." Such pressed powder cosmetic products beneficially are portable, do not spill, and are hygienic. These advantages are offset in the conventional pressed powder products by not being sufficiently "powder-like". That is, the conventional products are hard to the touch, and are more difficult to apply because the make-up composition is less likely to adhere to the brush or other applicator. Typical pressed powder cosmetics also tend to be somewhat friable. In accordance with the present invention, the pressed powder compositions have a silicone elastomer of low hardness, which results in a product form that has a certain degree of springiness and improved aesthetics. Consequently, the claimed present invention provides pressed powder products

that marry the benefits of the pressed powder products with the advantages of the powders.

Conventional pressed powder products have a hard surface, with good product release and silky cake feel. The purpose of the hard surface is so that the pressed powder passes a "drop test criteria." The drop test criteria is in essence a guarantee to consumers by a cosmetics manufacturer that the pressed powder will not shatter or break in the event that the pressed powder case is dropped. When a consumer or user applies one of these conventional hard cake pressed powders with a sponge applicator over the face, the sponge will typically absorb sebum from the face, over time causing "glazing." Glazing is a negative phenomenon in which the cake surface becomes hard and minimizes payoff/application on the face due to excess oil transferred over the cake from the sponge surface during repeated application and over time.

The products of the present invention provide for pressed powder that eliminates the phenomenon of glazing, with softer springy (non-hard) cake aesthetics. These compositions use a specific grade of silicone elastomer to

provide springiness in conjunction with specific percentages of dry binders and specific percentages of liquid binders that are able to pass the drop test criteria. In addition, the pressed powder cosmetic products of the claimed present invention achieve very unique springy surface properties and characteristics for ease of application, unlike conventional hard surface face powders. The pressed powder products of the present invention have a silicone elastomer that also has various other properties. For example, the silicone elastomer provides for sebum/oil control, satiny finish, softness to touch, and excellent adherence for longer wear, thereby providing clear advantages over conventional hard cake pressed powders.

Dobkowski et al. concerns the use of cross-linked siloxane elastomers in cosmetic powder compositions to incorporate water and water-soluble compounds into the powder system (see Col. 1, lines 29 et seq.), but nonetheless retaining the free-flowing powder nature of the composition. In this regard, Applicants refer to Example 1, Tables II and III of Dobkowski et al., in which the only example of the invention (Composition A) is a flowable

powder. This reference does not contemplate pressed powders, or the benefits of the present invention. Dobkowski et al. lacks any guidance regarding suitable siloxane elastomers that could be used to provide pressed powder cosmetic compositions that have the exceptional resiliency of the products of the present invention, as shown in Figure 1.

Applicants submit that Yoshimasa et al. concerns solid cosmetic compositions containing organopolysiloxane elastomers that have a degree of JISA hardness from 50 to 100. Thus, Yoshimasa et al. uses siloxane elastomers of high hardness value. In contrast, the pressed cosmetic powder compositions of the present invention require siloxane elastomers that have a hardness of less than 45, preferably from 2 to less than 45, and more preferably about 4 to about 35, and optimally about 20 to 35, which degree of hardness is considerably less than what is required by Yoshimasa et al.

Moreover, there is no basis to combine Yoshimasa et al. with Dobkowski et al. The latter reference only concerns loose powders, and in particular loose powders

that contain water, and especially aqueous emulsions. In a typical composition of the claimed present invention, the composition has a liquid binder, which is typically a hydrophobic oil. As required by claim 1, the compositions of the present invention also typically have from about 1% to about 25% of the silicone elastomer, by weight of the composition, as compared to the desired amount of the organopolysiloxane elastomer of high hardness value of 70 to 99% according to Yoshimasa et al.

Applicants note that Anderson is a European patent application first published September 26, 2001. As declared by Arvind Shah in the declaration under 37 C.F.R. 1.131(b) previously submitted in response to the Office Action dated October 3, 2003, the present invention antedates the date of first publication of Anderson. Therefore, Anderson is not a proper prior art reference under §103(a). The Office Action's §103(a) rejection is based on the combination of Dobkowski et al. and Anderson, in view of Yoshimasa et al. As such, Applicants respectfully request reconsideration and withdrawal of the §103(a) rejection with regard to Anderson.

Additionally, there is nothing in the disclosure of Anderson to suggest that Anderson contemplates a pressed powder cosmetic. There is no guidance whatsoever as to the hardness index of the elastomer to be used. There is no motivation or basis to combine the teachings of Anderson with those of Yoshimasa et al., inasmuch as the latter concerns compositions having very high levels of the elastomer, as compared to the low levels of elastomer contemplated by Anderson.

Unlike the aforementioned cited references, independent claim 1 covers a pressed powder cosmetic composition having about 1 wt% to about 25 wt% of silicone elastomer particulates based on the total weight of the composition, the silicone elastomer particulates having a JISA hardness index less than about 45, wherein the pressed powder cosmetic composition is obtained by compressing a loose powder mixture, and wherein the pressed powder composition has a hardness value less than about 1500 grams and a percent recovery of at least 25%.

In contrast to independent claim 1, and as conceded by the Examiner, there is nothing in any of the references

that discloses or suggests that the pressed powder cosmetic composition is obtained by compressing a loose powder mixture. Additionally, the references also do not disclose or suggest the claimed hardness indexes. For these reasons, as well as for the reasons set forth above, independent claim 1 is patentably distinguishable.

Claims 2 to 4, 6, 7, 9 to 12, 14 to 18, and 22 to 25 depend from claim 1, so they are also patentable for at least the same reasons as discussed above with respect to claim 1. Claims 5, 8, 13, and 19 to 21 have been cancelled, and claims 26 to 39 have been withdrawn from consideration, thereby rendering any rejections as to those claims moot.

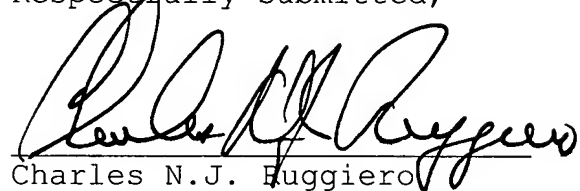
In view of the foregoing, Applicants respectfully submit that the claims of the present invention are allowable, and request that the rejections be reconsidered and withdrawn. Applicants respectfully urge that the claims of this application be given favorable consideration and immediate passage to allowance. In the event that further clarification is required prior to allowance,

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applicants respectfully request that the Examiner contact
Applicants' undersigned attorney.

Dated: March 29, 2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Charles N.J. Ruggiero", written over a horizontal line.

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ATTACHMENT A

RAY-RAN POLYTEST ADVANCED POLYMER TESTING EQUIPMENT

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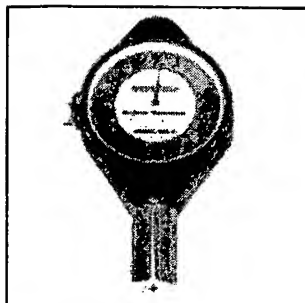
PRODUCT INFORMATION

SAMPLE & COMPONENT TESTING

TEST SAMPLE PREPARATION

RAW MATERIAL EVALUATION

CUTTERS



Hardness Testers/Durometers Shore Hardness Scales

Product Description

Analogue and Digital Shore Hardness Testers for Polymer Materials - Shore Range A,B,C,D,DO,OO.-----Hand held instrument- - Analogue 1 degree resolution -----Digital degree resolution----- Interchangeable Modules containing the Indicator and Spring.

Test Description

Fit the instrument with the correct Module. Place and Press the instrument perpendicular to the surface to be tested and read off the result.

Part Numbers

D202 with 1 Module -(can be used with WS777 Stand),----- M202 with 1 Module -(can be used with BS550 Stand), ----- M20200 For 00 Module.

Complies with Standard(s)

JIS K6301, ISO 7619, ISO 48, DIN 53519, DIN 53505, ASTM D2240, ASTM D1415

Literature

 [PDF - Hardness Testers](#)



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USPTO PATENT FULL-TEXT AND IMAGE DATABASE

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Searching 1790 to present...

ATTACHMENT B

Results of Search in 1790 to present db for:

ACLM/(jis AND hardness): 616 patents.

Hits 1 through 50 out of 616

[Next 50 Hits](#)

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[Refine Search](#)

PAT. NO.	Title
1 6,858,291	Elastic belt for papermaking calender
2 6,858,288	Wrap film
3 6,855,074	Multi-piece solid golf ball
4 6,855,071	Multi-piece golf ball and method for manufacturing the same
5 6,853,001	Electrode substrate of plasma display panel and method for making the same
6 6,852,399	Decorative material
7 6,846,250	Solid golf ball
8 6,846,247	Thread wound golf ball
9 6,844,632	Semiconductor pressure sensor device protected with perfluoropolyether gel
10 6,844,116	Transfer sheet for transferring protective layer for photographic emulsion face and photomask with protective layer
11 6,841,583	Composition and uses thereof
12 6,838,501	Golf ball material and golf ball
13 6,837,804	Two-piece solid golf ball
14 6,832,961	Wood-type golf clubhead
15 6,830,864	Method for transferring transparent conductive film
16 6,830,858	Electrophotographic photosensitive member, preparation method thereof, image forming process, apparatus and process cartridge using the same
17 6,824,730	Resin composition, gasket material and gasket integrated with metal
18 6,815,879	Circular fluorescent lamp including an insulator between conductive wires, and a lighting fixture using the lamp

- 19 [6,815,520](#)  [Addition curing type silicone resin composition](#)
- 20 [6,815,507](#)  [Golf ball with improved shot feel without deterioration in durability and flight performance](#)
- 21 [6,805,644](#)  [Three-piece solid golf ball](#)
- 22 [6,798,467](#)  [Liquid crystal display device and a method for producing the same](#)
- 23 [6,795,676](#)  [Sheet wrapping avoidable fixing apparatus and image forming apparatus](#)
- 24 [6,794,803](#)  [Spark plug for an internal combustion engine](#)
- 25 [6,794,801](#)  [Compact selfballasted fluorescent lamp and luminaire](#)
- 26 [6,793,996](#)  [Shoes](#)
- 27 [6,790,148](#)  [Multi-piece solid golf ball and method of making the same](#)
- 28 [RE38,589](#)  [Three-piece solid golf ball](#)
- 29 [6,786,836](#)  [Golf ball](#)
- 30 [6,786,261](#)  [Pneumatic tires](#)
- 31 [6,785,500](#)  [Image forming apparatus including image transfer body with elastic layer and coating layer](#)
- 32 [6,784,980](#)  [Thermal development apparatus and image recording apparatus](#)
- 33 [6,765,052](#)  [Olefin type thermoplastic elastomer](#)
- 34 [6,764,080](#)  [Rotation shaft seal](#)
- 35 [6,760,214](#)  [Electrostatic chuck for ion injector](#)
- 36 [6,760,155](#)  [Rear projection screen](#)
- 37 [6,759,482](#)  [Three-piece solid golf ball](#)
- 38 [6,759,001](#)  [Method for producing embossed poly\(vinyl alcohol\) film](#)
- 39 [6,758,766](#)  [Two-piece solid golf ball](#)
- 40 [6,758,253](#)  [Pneumatic tire with spirally wound reinforcing cord layer](#)
- 41 [6,757,508](#)  [Image carrier and damping member therefor](#)
- 42 [6,752,188](#)  [Pneumatic tire with specified bead portion](#)
- 43 [6,750,283](#)  [High-hardness, soft composite material](#)
- 44 [6,749,486](#)  [Chemical-mechanical polishing device, damascene wiring forming device, and damascene wiring forming method](#)
- 45 [6,746,347](#)  [Solid golf ball](#)
- 46 [6,746,345](#)  [Multi-piece solid golf ball](#)
- 47 [6,742,559](#)  [Pneumatic tire including wing rubber](#)
- 48 [6,739,986](#)  [Multi-piece solid golf ball](#)
- 49 [6,736,178](#)  [Pneumatic tire with specified bead portion](#)
- 50 [6,733,944](#)  [Image forming process](#)
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